REMARKS

Applicant has reviewed the Office Action mailed April 8, 2003. No claims are being amended or cancelled by this response. Thus, claims 1 through 35 are pending in the present application.

Claim Rejection – 35 U.S.C. §102

Claims 1 through 26 were rejected under 35 U.S.C. §102(e) as being anticipated by Darbee et al., U.S. Patent No. 6,130,726 (Darbee). Applicant respectfully disagrees.

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *W.L. Gore & Assocs. v. Garlock*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Further, "anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim." *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1982) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1984).

Regarding Claims 1, 8, 14 and 21, the Claims include the limitation of "determines whether event related program guide data is available in the second information handling system, and, in the event the event related program guide data is not available, the second information handling system sends a request for the program guide data to the first information handling system." Thus, the present claimed invention determines whether data is available in the second information handling system (e.g., a remote control device), and if it is not, sends a request to the first information handling system. In contrast, the Darbee reference is teaches a remote control 10 that receives information, from a first information handling system (e.g., consumer electronic device), based on the identity of the user. The remote control 10 then takes all the information received and filters/parses out the information according to the users preferences/viewing habits. Further, the remote control 10 is constantly monitoring the user and once the user is identified the remote control 10 monitors the commands entered from the user in order to retrieve/filter/parse out the appropriate data to be displayed to the respective user. Therefore, the Darbee reference fails to disclose, teach, or suggest determining whether the data is in the second information handling system (e.g., the remote control), and further does not disclose, teach, or suggest requesting the data from a first information

handling system after the second information handling system (e.g., remote control) has determined that the data is not available in the second information handling system, as claimed in the present invention. The Patent Office has not shown where such a disclosure, teaching or suggestion for "determining whether event related program guide data is available in the second information handling system, and, in the event the event related program guide data is not available, the second information handling system sends a request for the program guide data to the first information handling system[.]" is contained in the Darbee reference.

For example, in the present invention, if a new user were to utilize a remote and the information required was located in the remote, the remote would not need to access the set-top box as is required in Darbee. In Darbee, a selective download occurs upon the identification of the remote control unit itself, an identification of the user of the remote control or upon some assessment of the viewing habits or preferences of the user and not upon determination if the event related program data is located in the system (remote) itself. Thus, the Darbee reference does not disclose, teach or suggest "determines whether event related program guide data is available" and "in the event that related program guide data is not available, the second information handling system sends a request" as claimed.

In another example of the Darbee invention, suppose for the sake of argument that a second identified user in Darbee required the same information in the remote control as a first previously identified user, and thus, the information was already in the remote. The Darbee reference would still try to obtain the information from the set-top box regardless of the data stored in the remote. However, through use of the present invention, if the information was available in an information handling system, the information handling system would not need to query a set-top box and download the information again as in Darbee. Therefore, it is respectfully submitted that a *prima facie* case of anticipation had not been established, and withdrawal of the rejection is respectfully requested.

Claims 2-7, 9-13, 15-20, and 22-26 are believed to be allowable based on dependence from allowable claims 1, 8, 14, and 21.

Claim Rejection – 35 U.S.C. §103

Claims 27 through 35 were rejected under 35 U.S.C. §103(a) as being unpatentable over Darbe et al., U.S. Patent No. 6,130,726 (Darbee). The Applicant respectfully disagrees.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Ryoka*, 180 U.S.P.Q. 580 (C.C.P.A. 1974). *See also In re Wilson*, 165 U.S.P.Q. 494 (C.C.P.A. 1970). With respect to claim 27, guide data is displayed by **both** the first information handling system and the second information handling system, which is not taught or suggested by the submitted reference. The Patent Office correctly asserts that "However, Darbee remains silent on [the] being capable of displaying program content and displaying program guide data on the television receiver or set-box (first display)."

The Patent Office then asserts various portions of the Darbee reference for support of displaying guide data on a first device. For example, the Patent Office first asserts Col. 1, Lines 29-39, which states the following.

> Electronic Program Guides (EPGs) or Interactive Program Guides (IPGs) are application which normally run on a screen of a television set or on a set-top box, with the program guide information appearing on the screen of the television. The problem with this approach is that the guide data must either replace or overlay the program that the user is watching, thus interfering with normal program viewing. This is especially a problem when a group of people is watching the television set and only one of them (usually the one with the remote control) wants to access the program guide. *Darbee, Col. 1, Lines 29-39.*

This section teaches the undesirability of showing guide data on a first device. Indeed, Darbee even gives an extensive listing of patents, and then asserts the following.

> However, in all instances, the program data is limited to information concerning a particular song or video title that is being or may be broadcast, and there is no suggestion that the program data could or should include graphic program scheduling or advertising data. A typical program message includes, for example, information concerning the composer, track title, the artist and the album associated with the track title. *Darbee, Col. 2, Lines 17-22*

Thus, Darbee suggests that in "all instances", the data is only displayed on the viewing device, because "those skilled in the art failed to fully appreciate the usefulness of a

remote control device." *Darbee, Col. 2, Lines 27-29.* To address these problems, Darbee provides data on the remote control unit 10, and NOT the viewing device, i.e., television, and teaches away from displaying data on the viewing device, "without causing an interruption in content that is being depicted on an associated television monitor." *Darbee, Col. 2, Lines 48-49.*

As the Office is aware, obviousness cannot be established by combining the teaching of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. *ACS Hosp. Sys., Inc. v. Montefiore Hosp.,* 732 F.2d 1572, 221 USPQ 929 (Fed. Cir. 1984). Thus, the Office may not use the patent application as a basis for the motivation to combine or modify the prior art to arrive at the claimed invention.

> The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. .... It is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *In re Oetiker*, 977 F.2d 1443, 24 USPQ 2d 1443 (Fed. Cir. 1992) *quoting In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988).

In the present case, the Office has selected portions from the Darbee reference and the prior art in general to arrive at the present invention, in which, neither Darbee or the prior art cited by Darbee supply the motivation for combining Darbee and the prior art as proposed by the present invention. Rather, Darbee and the prior art cited by it are relied upon for selected elements, but the desirability of the elements in the combination has not been supplied absent the present application. Since the Darbee reference and the prior art cited by the Darbee reference do not supply the desirability of the modification, it is respectfully submitted that a *prima facie* case of obviousness has not been established.

The presently claimed invention claims displaying the guide data on BOTH the first information handling system and the second information handling system. "A prior

art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." *M.P.E.P. 2131.02, citing W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). In the present case, the Patent Office's proposed modification to the *Darbee* reference would change the reference in such a way as to be contradictory to the problem it is trying to solve, as stated by the reference itself. The submitted reference, including the submitted portions, fail to teach or suggest the display of guide data on BOTH the first information handling system and the second information handling system. Therefore, it is respectfully submitted that a *prima facie* showing of obviousness has not been established, and withdrawal of the rejection is respectfully requested.

Further, the Patent Office is undoubtedly aware, that the combination of "Old" or "Well-Known" Elements to solve different problems renders an invention non-obvious. As stated by the court in *Lindermann Maschinenfabrik BmbH v. American Hoist & Derrick Co.*, 221 USPQ 488, "The '315 patent specifically stated that it disclosed and claimed a combination of features previously used in two separate devices. That fact alone is not fatal to patentability. The claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination..." The use of display devices on a first and second information handling system and the content of the display, i.e., electronic programming guide, advertising, and the like, may be known in the art. However, the present invention addresses the need for simultaneous display of that information on the first and a second information handling system. The Darbee reference addresses the need for the display of information on a remote device to avoid the problem of displaying such information on a second device. The prior art cited by the Darbee reference merely states a solution to displaying information, i.e., an electronic program guide, and the like, on a single device. Nowhere in Darbee or the prior art cited by Darbee is it taught or suggested that the simultaneous display of information as provided by the present invention is desired. In fact, as stated above, the Darbee reference teaches away from the simultaneous display of the present invention. Therefore, Applicant respectfully requests withdrawal of the rejection.

The Patent Office states that it would have been obvious to one of ordinary skill in the art to utilize a conventional television display in combination with the Darbee remote device in order to provide the present invention. As the Office is well aware, Applicant is required to seasonably challenge statements by the Office that are not supported on the record, and failure to do so will be construed as an admission by Applicant that the statement is true. M.P.E.P. §2144.03. Therefore, in accordance with Applicant's duty to seasonably challenge such unsupported statements, the Office is hereby requested to cite a reference supporting the position that it would have been obvious to utilize a conventional television display and the remote device in accordance with the claimed invention. If the Office is unable to provide such a reference, and is relying on facts based on personal knowledge, Applicant hereby requests that such facts be set forth in an affidavit from the Patent Office under 37 C.F.R. 1.104(d)(2). Absent substantiation by the Patent Office, it is respectfully requested that the rejection under 35 U.S.C. § 103 be withdrawn.

Further, regarding Claims 31-35, the Claims pertain to a method of displaying data on a first information handling system and a second information handling system, which is not disclosed, taught or suggested by the references. Therefore, the Applicant respectfully requests that the rejection be withdrawn and the claims allowed.

CONCLUSION

In light of the forgoing, reconsideration and allowance of the claims is earnestly solicited.

Respectfully submitted,
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